

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

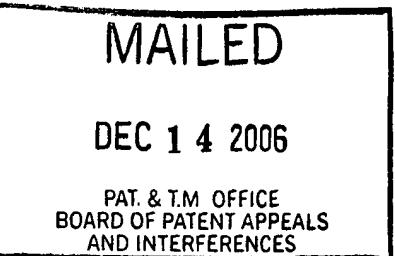
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TSUYOSHI KITAHARA

Appeal No. 2006-2395
Application No. 09/708,514

ON BRIEF



Before THOMAS, HAIRSTON, and BLANKENSHIP, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is a remand of the appeal under 35 U.S.C. § 134 from the rejections of claims 1, 3, 4 and 54 in accordance with 37 CFR § 41.50(a)(1). After considering the record before us, we are convinced that the instant appeal is not ready for meaningful review. Accordingly, we hereby remand this application to the examiner to consider the following issue and to take appropriate action.

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In formulating the rejection under 35 U.S.C. § 102 at page 3 of the final rejection the examiner relies upon Nakamura (JP08-187868). This is the same reference identified by appellant at page 11 of the principal brief on appeal and page 3 of the reply brief.

On the other hand, the examiner relies on a published Japanese document to Nakamura identified as JP06-023982 beginning at the bottom of page 2 of the answer. Page 3 of the answer states the rejection of independent claim 1 under 35 U.S.C. § 102 relying on this reference.

In light of the above facts it appears to us that the examiner may have intentionally or inadvertently instituted a new ground of rejection in the answer because the so-called Nakamura reference relied upon by the examiner in the answer is not the same reference identified by publication number in the final rejection. The publication number JP06-023982 does not list as any of the

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inventors a person named Nakamura. To insure that the examiner is not instituting a new ground of rejection in the answer, the record must reflect for a meaningful decision on appeal that the examiner and appellant are referring to the same reference without ambiguity or confusion. Therefore, this application is remanded to the examiner to clarify the record as to which reference is relied upon as a basis to reject independent claim 1 on appeal under 35 U.S.C. § 102. The certainty of which reference is relied upon under 35 U.S.C. § 102 bears upon the rejection of the remaining claims on appeal, claims 3, 4 and 54, since a reference to Nakamura is relied upon further in view of another patent, to Usui, within 35 U.S.C. § 103.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

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This application is accordingly remanded to the examiner for further action consistent with the foregoing.

REMANDED

JAMES D. THOMAS)
Administrative Patent Judge)
KENNETH W. HAIRSTON) BOARD OF PATENT APPEALS
Administrative Patent Judge) AND
HOWARD B. BLANKENSHIP) INTERFERENCES
Administrative Patent Judge)

James D. Thomas
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